

Docket No. 30990156-2 US (1509-144)

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PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	
Inventors: Richard Oliver KAHN et al.	: Confirmation No: 6041
	:
U.S. Patent Application No. 09/788,669	: Group Art Unit: 2612
:	
Filed: February 21, 2001	: Examiner: J. VILLECO
:	
For: PORTABLE INFORMATION CAPTURE DEVICE (as amended)	

REPLY BRIEF

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MaiStop POBA
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

Further to Appellants Brief on Appeal filed October 25, 2005, herewith is Appellant's Reply Brief to the Examiner's Answer of January 12, 2006.

To the extent necessary, Appellant hereby requests any required extension of time under 37 C.F.R. §1.136 and hereby authorizes the Commissioner to charge any required fees not otherwise provided for to Deposit Account No. 08-2025.

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571-273-8300

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Serial No. 09/788,669

Appellants submit this Reply Brief because of the shifting positions of the Examiner and some new arguments set forth in the Examiner's Answer.

A key aspect of the Board's consideration of this case is that Torres does not provide the requirement of independent claim 1 for a controller that selects which information records to compress and how far to compress a particular information record on the basis of a priority rating of the particular information record, and the similar requirement of independent claim 16 for a controller that selects which information records to compress, and how far to compress these information records on the basis of priority ratings of the information records. The Examiner's position on these critical limitations has vacillated between allegations that the limitations are disclosed by Torres, as set forth in the Final Rejection, to a statement that the limitation is inherent as set forth in the Advisory Action, and apparently back to the position of Final Rejection, as set forth in the Examiner's Answer. In this regard, the Final Rejection, on page 2, Item 3, states:

However, it is clear from col. 6, lines 13-32 of Torres that priority ratings are given to files and selects [sic] certain images to compress. Additionally, Torres discloses that certain files are not compressed and that certain files are compressed further from a JPEG format to a wavelet compression format.

In response to Appellants' response to the Final Rejection which pointed out why the Examiners' reasoning was improper, the Examiner in the Advisory Action stated, on page 3, second paragraph, last two sentences:

If the image has not been compressed to the predetermined level, the file is compressed to the predetermined level. Thus, a determination is inherently made as to how far to compress the image file if it has not already been compressed to the predetermined level.

In response to Appellants' main Brief which pointed out that the Examiner failed to comply with applicable law on the point of inherency, the last sentence on page 11 of the Examiner's Answer states:

Serial No. 09/788,669

In response to the applicant's insistence that the inherency statement used in the Advisory Action is improper, the examiner points out that the inherency statement was merely used to explain that it is inherent that the predetermined level of Torres can be interpreted as "how far" to compress an image.

The apparent shifting position of the Examiner between what Torres discloses and what the Examiner considers as inherent in Torres demonstrates the weakness of the Examiner's position with regard to the rationale that Torres provides the aforementioned limitations of claims 1 and 16.

The statements about the Torres disclosure with regard to priority and compression, as set forth in the only full paragraph on page 11 of the Examiner's Answer, are not supported by Torres. The only portion of Torres that discusses priority in connection with compression is found in the first full paragraph in column 6 of the Torres reference. It is there indicated that a user could tag files that have actually been copied/archived as the highest priority candidates for further compression, i.e., compression beyond the JPEG compression to which all of the Torres images are subjected. If such a procedure is performed, the process of Figure 6 is modified so that prior to the process of Figure 6 being performed, a check is made of files tagged with priority to perform the compression step of Figure 6. In other words, if a particular file has been copied or archived, it has a priority for compression that is not applicable to a file that has not been archived or copied.

Hence, Torres discloses the requirement of claim 1 for selecting which information records to compress on the basis of a priority rating of the particular information record, but it does not disclose how far to compress the particular information record based on the priority rating of the information record. There is simply no support for the Examiner's interpretation of Torres that when a given particular record in Torres is detected, that file is compressed to a predetermined level based on the priority level of that record. In Torres, there is only one priority level after the JPEG compressed image has been stored, i.e., either further compression or no further compression. The further compression that Torres refers to is compression beyond the JPEG compression that all images in the Torres camera undergo. Since all the Torres images are stored in a JPEG compressed state, the decision to further compress the

Serial No. 09/788,669

JPEG images based on priority, involves only a decision to compress as a JPEG image or to compress a JPEG image beyond the JPEG compression level, and which images are to be compressed beyond the JPEG compression level.

The statement set forth at the top of page 12 of the Examiner's Answer concerning claim 25 is untenable. As previously discussed, Torres either compresses or does not compress a JPEG image. Such a one step compression level does not meet the requirements of claim 25 for a particular information record to be compressed by a variable amount on the basis of the priority rating of the particular information record.

The reliance on column 5, lines 10-25 of Torres to make obvious the requirements of claim 15, as set forth in the last full paragraph on page 12 of the Examiner's Answer, is incorrect. Claim 15 requires a class of information records be given a common priority rating. Column 5, lines 10-25 of Torres is concerned with category tags 735 that are stored in the camera. There is no nexus between category tags 735 and the compression method Torres describes in connection with Figure 6. The Examiner's Answer gives no reason why one of ordinary skill in the art would have modified Torres so that the records having the same category tag would have the same priority rating.

In the only full paragraph of page 13 of the Examiner's Answer, the Examiner states Applicant concedes that claims 2 and 8 do not include patentable material. This is a misstatement of Appellants' position. Appellants' position is that the combination of the structure of claim 1 with the deletion feature of claim 2 is patentable, as is the combination of claims 1, 7 and 8. According to claims 1 and 8, the priority compression feature of claim 1 is in combination with the option of completely deleting a particular record from the memory of the portable information record capture device.

Appellants can not agree with the statement in the paragraph bridging pages 13 and 14 of the Examiner's Answer that states: "The fact that Imai is not implemented in a camera is irrelevant." The problem of adequate memory space in a digital camera, as disclosed by Torres, is far greater than the memory space problems of a computer. Typical modern computers have many gigabytes of memory capacity. A typical digital camera has a removable semi-conductor memory on a card, typically having a capacity of approximately $\frac{1}{4}$ or $\frac{1}{2}$

Serial No. 09/788,669

gigabyte. One of ordinary skill in the art would not have looked to the computer art to resolve the memory problems of a digital camera. The Examiner's Answer fails to deal with the *Wang Laboratories, Inc. v. Toshiba Corporation*, 993 F.2d, 858, 26 U.S.P.Q. 767 (Fed. Cir. 1993) decision cited by Appellant in its main Brief with regard to the issue of non-analogous art.

The comments in the only full paragraph on page 14 concerning claim 3 are inapposite. Claim 3 requires the priority record to include a maximum permissible compression level for each information record. In other words, claim 3 requires each information record to be compressed only so far, to a maximum permissible compression level. The discussion of Torres at column 6, lines 25 on page 14 of the Examiner's Answer concerns no further compression of an image file. In other words, Torres indicates certain image files cannot be compressed other than for JPEG compression. The maximum compression level referred to in claim 3 is just the opposite of the lack of further compression Torres refers to at column 6, line 25. As Appellants have discussed previously in this Brief, Torres discloses either no compression beyond a JPEG compression or compression to a predetermined compression level.

With regard to claim 9, discussed in the first full paragraph on page 15 of the Examiner's Answer, the Examiner gives no reason what the motivation would have been for one of ordinary skill in the art to have modified Torres to include the Oie feature of receiving images from a remote source to be stored in a memory.

The paragraph bridging pages 15 and 16 of the Examiner's Answer states the Torres central processing unit would have to do some type of calculation to associate priority tags with an image. However, claim 17 requires a controller to calculate a priority rating of a newly received information record. It is not true that the Torres central processing unit 344 would have to calculate the priority rating according to predetermined criteria. The implication from Torres, at column 6, lines 14-23, is that a user determines which files have priority to be compressed. In this regard, Torres states:

For example, a user may know that certain files that are still being carried in the camera have actually been copied/archived. Thus, a user could tag these files when viewed in review mode, such as through a menu selection item, as the highest priority candidates for further compression.

Serial No. 09/788,669

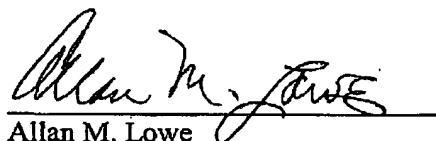
Thus, there is no basis for the position of the Examiner regarding claim 17, as set forth in the Examiner's Answer.

Based on the foregoing, the various rejections are wrong, and reversal of the Examiner is in order.

Respectfully submitted,

Richard Oliver KAHN et al.

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